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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
THOMPSON, JAMES A	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,580	HULL ET AL.	
	Examiner	Art Unit	
	James A. Thompson	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 3/30/04,12/28/04,10/31/05,4/17/06. 10/2/06,11/6/06,2/2/07,4/26/07, 7/20/07,9/6/07,10/26/07.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-21 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 30 March 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date See Continuation Sheet.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :3/30/04,12/28/04,10/31/05,4/17/06,10/2/06,11/6/06,2/2/07,4/26/07,7/20/07,9/6/07,10/26/07.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 7-12, 16 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Iida (US Patent 6,123,258).

Regarding claims 1 and 20: Iida discloses a printer (figure 1 of Iida), comprising: means for receiving (figure 1(106) of Iida) by a printer a document having document content (figure 1 and column 10, lines 1-17 of Iida – *document input into the printer system, the document containing embedded codes as part of the overall document content*); and means for performing (103) by the printer, in response to receipt of the document, an action in accordance with the document content of the received document (column 10, lines 18-40 of Iida – *printer performs variety of actions based on the type of content received from the document*).

Further regarding claim 1: The printer of claim 20 performs the method of claim 1.

Regarding claim 2: Iida discloses printing the received document (column 6, lines 62-65 of Iida – *printer is one of the output devices for reproducing the original [received] information*).

Regarding claim 7: Iida discloses that the document content of the received document includes user-provided data (column 6, lines 20-33 of Iida – *user inputted attribute data part of input document*).

Regarding claim 8: Iida discloses that the document content of the received document includes data that is the result of analysis by a document rendering application on a computer that is the source of the document (column 10, lines 7-17 of Iida – *document analyzed to determine embedded data*).

Regarding claim 9: Iida discloses performing, by the printer, analysis of the content of the received document (column 10, lines 7-17 of Iida – *document analyzed to determine embedded data*), wherein performing an action based on the document content of the received document further comprises performing an action in accordance with a result of the analysis by the printer (column 10, lines 14-28 of Iida – *extracted data pieces reproduced according to analysis of pieces*).

Regarding claim 10: Iida discloses that the printer is a local printer (figure 1(20c) and column 6, lines 62-67 of Iida – *printer (20c) is local printer*).

Regarding claim 11: Iida discloses that the printer is a remote printer (figure 1(10f,20e) and column 6, lines 57-67 of Iida – *printer is connected to network at both input (10f) and output (20e), and is thus a remote printer with respect to other network-connected devices*).

Regarding claim 12: Iida discloses that the action comprises updating a database in accordance with the content of the document (column 10, lines 26-33 of Iida – *classified/sorted pieces of extracted data updated*).

Regarding claim 16: Iida discloses sending an interactive request to a source of the document and waiting to receive a response before performing the action (column 17, lines 5-20 of Iida – *user must designate which of multiple types of information is to be reproduced before reproduction of data*).

Regarding claim 21: Iida discloses using digital information processors to process digital information (see, *e.g.*, figure 1 and column 6, lines 15-33 of Iida), and thus discloses a computer program product having a medium storing computer instructions capable of performing a method (inherent in a digital data computational system), the method comprising: receiving a document to be printed (column 6, lines 62-65 of Iida – *printer is one of the output devices for reproducing the original [received] information*), the document having document contents (figure 1 and column 10, lines 1-17 of Iida – *document input into the printer system, the document containing embedded codes as part of the overall document content*); creating a non-printing command to the document, the command instructing a printer to perform an action besides printing relating to the document content (column 10, lines 18-40 of Iida – *printer performs variety of actions based on the type of content received from the document*).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3-6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iida (US Patent 6,123,258) in view of Nickerson (US Patent 6,043,904).

Regarding claim 3: Iida does not disclose expressly printing a confirmation of completion of the performed action.

Nickerson discloses printing a confirmation of completion of a performed action (column 9, lines 20-26 of Nickerson).

Iida and Nickerson are combinable because they are from similar problem solving areas, namely how to obtain and provide needed information with respect to a print job/process. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide a printed confirmation that the print job is completed. The motivation for doing so would have been to allow the user to know if and when the print job is done, and thus not have to wait at the print location until the print job is completed. Therefore, it would have been obvious to combine Nickerson with Iida to obtain the invention as specified in claim 3.

Regarding claims 4-5: Iida does not disclose expressly sending a message confirming completion of the performed action, wherein the message is an email sent to the source of the document.

Nickerson discloses sending a message confirming completion of a performed action, wherein the message is an email sent to the source of the document (column 10, lines 50-62 of Nickerson – *confirmation email sent to originator of print job when print job completed*).

Iida and Nickerson are combinable because they are from similar problem solving areas, namely how to obtain and provide needed information with respect to a print job/process. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide an email confirmation that the print job is completed. The motivation for doing so would have been to allow the user to know if and when the print job is done, and thus not have to wait at the print location until the print job is completed. Therefore, it would have been obvious to combine Nickerson with Iida to obtain the invention as specified in claims 4-5.

Regarding claim 6: Iida discloses printing the received document (column 6, lines 62-65 of Iida – *printer is one of the output devices for reproducing the original [received] information*).

Iida does not disclose expressly that the action comprises printing a certificate confirming that content of the printed document is equal to data provided to the action taken.

Nickerson discloses printing a certificate (confirmation page) confirming that content of the printed document is equal to data provided to the action taken (column 9, lines 20-26 of Nickerson – *confirmation page printed that informs user that the print job is completed, and thus content of the printed document is equal to the data [print job data] provided to the action taken [printing the print job]*).

Iida and Nickerson are combinable because they are from similar problem solving areas, namely how to obtain and provide needed information with respect to a print job/process. At the time of the

invention, it would have been obvious to a person of ordinary skill in the art to provide a printed confirmation that the print job is completed. The motivation for doing so would have been to allow the user to know if and when the print job is done, and thus not have to wait at the print location until the print job is completed. Therefore, it would have been obvious to combine Nickerson with Iida to obtain the invention as specified in claim 6.

Regarding claim 13: Iida does not disclose expressly that the action comprises sending an email confirming printing of the document.

Nickerson discloses sending an email confirming printing of the document (column 10, lines 50-62 of Nickerson – *confirmation email sent to originator of print job when print job completed*).

Iida and Nickerson are combinable because they are from similar problem solving areas, namely how to obtain and provide needed information with respect to a print job/process. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to provide an email confirmation that the print job is completed. The motivation for doing so would have been to allow the user to know if and when the print job is done, and thus not have to wait at the print location until the print job is completed. Therefore, it would have been obvious to combine Nickerson with Iida to obtain the invention as specified in claim 13.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iida (US Patent 6,123,258) in view of Ying (US Patent 6,853,980 B1).

Regarding claim 14: Iida does not disclose expressly that the action comprises monitoring a use of fonts in a document to assure compliance with a license for the fonts.

Ying discloses monitoring a use of fonts in a document to assure compliance with a license for the fonts (column 2, line 59 to column 3, line 5 of Ying).

Iida and Ying are combinable because they are from the same field of endeavor, namely processing and printing documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to monitor the use of fonts in the documents to be printed. The motivation for doing so would have been to allow the user to use a variety of different fonts, which for some requires the license payments in order to use the fonts legally. Therefore, it would have been obvious to combine Ying with Iida to obtain the invention as specified in claim 14.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iida (US Patent 6,123,258) in view of Imai (US Patent 4,619,522).

Regarding claim 15: Iida does not disclose expressly that the action comprises monitoring a use of halftones in the document.

Imai discloses monitoring a use of halftones in the document (column 7, lines 47-66 of Imai – *use of halftones monitored by detecting amount of toner used to form halftone dots for printing*).

Iida and Imai are combinable because they are from they are from similar problem solving areas, namely how to efficiently process and print documents. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to monitor how much toner (and thus halftones) are used in a document. The motivation for doing so would have been to maintain printed image density (column 8, lines 7-20 of Imai). Therefore, it would have been obvious to combine Imai with Iida to obtain the invention as specified in claim 15.

7. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iida (US Patent 6,123,258) in view of Steinberg (US Patent 6,904,168 B1).

Regarding claim 17: Iida does not disclose expressly that the printer analyzes the content of the document for pornography and wherein the action comprises sending a notice if pornography is found.

Steinberg discloses analyzing the content of a document for pornography (figure 3 and column 7, lines 9-15 of Steinberg) and sending a notice if pornography is found (column 7, lines 14-15 and lines 60-65 of Steinberg – *whether automatically or manually determined, if a picture is deemed pornographic, a notice is sent to the database which is accessible by the users*).

Iida and Steinberg are combinable because they are from the same field of endeavor, namely the analysis of document image data properties and the performance of various actions based on the determined document image data properties. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to analyze a document for pornographic images, and send a notice is such an image is found. The motivation for doing so would have been to maintain ethical and decency standards at an organization and prevent waste of resources. Therefore, it would have been obvious to combine Steinberg with Iida to obtain the invention as specified in claim 17.

8. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iida (US Patent 6,123,258) in view of Eaton (US Patent 7,092,568 B2).

Regarding claim 18: Iida does not disclose expressly that the printer analyzes the content of the document for confidential terms, and wherein the action comprises sending a notice if confidential terms are found.

Eaton discloses analyzing the content of a document for confidential terms, and sending a notice if confidential terms are found (figure 5 and column 5, lines 20-27 of Eaton).

Iida and Eaton are combinable because they are from the same field of endeavor, namely the analysis of document image data properties and the performance of various actions based on the determined document image data properties. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to analyze a document for confidential terms, and send a notice is such a term is found. The motivation for doing so would have been to maintain security over confidential documents in an organization. Therefore, it would have been obvious to combine Eaton with Iida to obtain the invention as specified in claim 18.

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iida (US Patent 6,123,258) in view of Kofman (US Patent 7,196,808 B2).

Regarding claim 19: Iida does not disclose expressly that the printer performs optical character recognition of a received postscript document, and wherein the action comprises an action in accordance with a result of the optical character recognition.

Kofman discloses performing optical character recognition of a received postscript document (column 20, lines 4-12 of Kofman), and performing an action in accordance with a result of the optical character recognition (column 20, lines 16-20 of Kofman – *search performed based on results of OCR*).

Iida and Kofman are combinable because they are from the same field of endeavor, namely the analysis of document image data properties and the performance of various actions based on the determined document image data properties. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to perform OCR on a received Postscript document file and search the resultant text. The motivation for doing so would have been to detect keywords (such as "confidential" or "top secret") which denote that the document should not be disseminated (column 20, lines 18-26 of Kofman). Therefore, it would have been obvious to combine Kofman with Iida to obtain the invention as specified in claim 19.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James A. Thompson
Examiner
Technology Division 2625

5 January 2008